Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID LESLIE COHEN
and ROGER BLAIR COHEN

Appeal No. 2000-0076
Application 08/970,231

HEARD: November 28, 2000

Before ABRAMS, MCQUADE, and LAZARUS, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

David Leslie Cohen et al. appeal from the final rejection of claims 1 through 44, all of the claims pending in the application.

THE INVENTION

The invention relates to "a movable manufacturing facility that can be erected near a large housing development

to efficiently manufacture standard size dwellings,

substantially in

their entirety, in a factory environment prior to transporting

and placing these completed dwellings on pre-constructed

permanent foundations" (specification, page 1). Claim 1 is

illustrative and reads as follows:

1. A manufacturing facility for constructing standard size dwellings substantially in their entirety, said manufacturing facility being located proximate a location at which standard size dwellings are to be sited said manufacturing facility comprising:

a plurality of subassembly production lines, at least two of said subassembly production lines being used for constructing predetermined subassemblies for said standard size dwelling, each of said predetermined subassemblies comprising a structural section of said standard size dwelling, from the class of structural sections including: walls, floors, roof, foundation base frame;

a dwelling assembly alley for assembling a partially assembled standard size dwelling therein;

hoisting means operational in each of said at least two subassembly production lines for transporting said constructed predetermined subassemblies to said dwelling assembly alley for incorporation into a partially assembled standard size dwelling being assembled therein; and

wherein said standard size dwelling is assembled substantially in its entirety in said dwelling assembly alley using said predetermined subassemblies, which are incorporated into said partially assembled standard sized dwelling.

THE EVIDENCE

The items relied on by the examiner as evidence of obviousness are:

Rizk	4,546,530	Oct. 15, 1985
Biffis et al. (Biffis)	5,402,618	Apr. 4, 1995

"Multi-Story Spacesetter Building Systems," Chief Industries brochure, 1986

"Extending the Limits of Functional Buildings," Chief Industries brochure, 1992

The items relied upon by the appellants as evidence of non-obviousness are:[1]

The 37 CFR § 1.132 Declaration of Randal A. Parsley filed July 9, 1998 (Paper No. 21)

The 37 CFR § 1.132 Declaration of Garry D. Myers filed July 9, 1998 (Paper No. 21)

THE REJECTIONS

Claims 12, 17 through 20, 23 and 28 through 38 stand rejected under 35 U.S.C. § 112, second paragraph, as failing

[1] The record also contains a 37 CFR § 1.132 Declaration of David L. Cohen filed May 27, 1997 (Paper No. 13) which the appellants have not chosen to rely on in this appeal.

to particularly point out and distinctly claim the subject matter the appellants regard as the invention.

Claims 1, 4, 5, 8, 9, 12 and 15 through 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Biffis in view of Rizk.

Claims 2, 3, 6, 7, 10, 11, 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Biffis in view of Rizk and the two Chief Industries brochures.

Attention is directed to the appellants' main and reply briefs (Paper Nos. 31 and 34) and to the examiner's final rejection and answer (Paper Nos. 19 and 32) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 112, second paragraph, rejection of claims 12, 17 through 20, 23 and 28 through 38

The 35 U.S.C. § 112, second paragraph, rejection of claims 12, 17 through 20, 23 and 28 through 38 has not been argued by the appellants in the briefs or restated by the examiner in the answer. This failure to address the rejection

on appeal appears to be the result of an agreement between the appellants and the examiner that the rejection would be overcome by certain amendments submitted subsequent to final rejection (see the advisory action mailed September 22, 1998, Paper No. 27; page 5 in the main brief; and page 2 in the answer). The examiner, however, has refused to enter the amendments for unrelated reasons. Thus, the rejection remains in effect, and we shall summarily sustain it since the appellants have not challenged its merits.

II. The 35 U.S.C. § 103(a) rejections of claims 1 through 44

Claims 1, 27 and 39, the three independent claims on appeal, recite a manufacturing facility for constructing standard size dwellings comprising, inter alia, at least two subassembly production lines for constructing predetermined subassemblies for the standard size dwelling, a dwelling assembly alley for assembling a partially assembled standard size dwelling therein, and hoisting means operational in the at least two subassembly production lines for transporting the predetermined subassemblies to the dwelling assembly alley for incorporation/installation into a partially assembled standard size dwelling.

Biffis, the examiner's primary reference, discloses a building production line 10 located on-site in the midst of a subdivision 80 of building lots 82 (see Figure 8). As described in the reference,

> production line 10 is a factory-like facility in which two parallel production lines, 11 and 12, are placed side by side. The production lines each include its own railway track 14, 15 extending through the assembly facility past a basic construction area 16 and then past a plurality of bays 18 providing storage space for light construction and finishing materials such as window frames and doors, plumbing and electrical supplies. Basic construction area 16 and bays 18 are collectively referred to as "work stations". Running on the tracks 14 and 15 are a plurality of transporting devices 20 each comprising a flatbed 21 (see FIG. 2) having a series of railway track engaging wheels 22 there beneath and anti-friction surfaces, such as roller conveyors 24, on the upper surfaces of the flatbed.
>
> As the devices 20 proceed from left to right as seen in FIG. 1, the building unit 30 is erected on the base member of the system . . . . Fabrication of the building unit 30 continues throughout the production line until finally it is rolled out to a loading bay 25 on the right hand side of FIG. 1. Here a means to transport the prefabricat[ed] building unit to the building site is provided in the form of a flatbed truck 26 which is dimensioned so that the building unit 30 can be slid off the roller conveyors 24 on the flatbed 21, onto the flatbed 27 of the truck 26 which itself has an anti-friction surface on top of its flatbed, which anti-friction surface may be a roller conveyor 28 similar to the roller conveyor 24.

> The prefabricated unit 30 is then conveyed to the building site by the truck 26 where it is lifted into position by means of a crane 32 (see FIG. 3) onto the building foundation 33 [column 3, lines 27 through 60].

In applying Biffis to support the obviousness rejection of independent claims 1, 27 and 39 (see pages 4 and 5 in the answer), the examiner finds correspondence between the subassembly production lines recited in the claims and Biffis' basic construction area 16 and storage bays 18, and between the dwelling assembly alley recited in the claims and Biffis' parallel production lines 11 and 12 and railway tracks 14 and 15. These findings are untenable inasmuch as the foregoing elements
in the Biffis facility simply do not constitute subassembly production lines and an associated dwelling assembly alley as recited in claims 1, 27 and 39. The examiner's ambiguous and unsubstantiated references to well known plant layouts, common sense and industrial engineering concepts (see pages 6 and 11 in the answer) afford no cure for these shortcomings.

Rizk, the examiner's secondary reference, discloses a plant (see Figure 6) for producing building modules which "are transported to a proposed building site where they are set in

place as a single module structure, or are coupled to other modules to yield a composite building" (column 1, lines 10 through 13). The plant includes a component preparation area 100, subsection fabrication areas 200, 300, 400 and 500, a final assembly site 600, overhead cranes OC for transporting elements from the component preparation area to the various subsection fabrication areas and then to the final assembly site, a concrete floor pouring station 800, a concrete curing station 810, a finishing area 900 composed of a variety of finishing stations 905-950, and transport means (e.g., casters) for sequentially moving the final assembly to the concrete floor pouring station, the curing station and the finishing stations.

Like Biffis, Rizk fails to disclose subassembly production lines and an associated dwelling assembly alley as recited in claims 1, 27 and 39. Thus, Rizk does not overcome the above noted deficiencies of Biffis. The same is true of the Chief Industries brochures which are cited for their disclosures of knock-down building structures.

Hence, the combined teachings of the applied references would not have suggested the subject matter recited in claims 1, 27 and 39 to one of ordinary skill in the art. In other words, these references, even if assumed to be analogous art (the appellants argue that they are not), fail to establish a prima facie case of obviousness with respect to such subject matter.[2] Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 1, 27 and 39 or of dependent claims 2 through 26, 28 through 38 and 40 through 44.

III. New ground of rejection

The following new rejection is entered pursuant to 37 CFR § 1.196(b).

Claims 1, 27 and 39, and dependent claims 2 through 26, 28 through 38 and 40 through 44, are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point and distinctly claim the subject matter the appellants regard as the invention.[3]

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[2] This being so, there is no need to delve into the merits of the appellants' declaration evidence of non-obviousness.

[3] This rejection is separate and distinct from the examiner's 35 U.S.C. § 112, second paragraph, rejection.

As indicated above, independent claims 1, 27 and 39 recite a manufacturing facility comprising, inter alia, subassembly production lines for constructing predetermined subassemblies. These claims further require the subassemblies to comprise a structural section from a "class" of structural sections, the "class" being variously defined as "including" "walls, floors, roof, foundation base frame" (claim 1), "walls, floors, roof trusses, roof, foundation base frame" (claim 27) and "walls, floors, roof" (claim 39). The use of the open-ended term "including" to define the "class" (as opposed to the closed-ended phrase "consisting of") leaves the class open to the inclusion of other unspecified elements. See MPEP § 2111.03. Given the lack of any relevant discussion in the underlying specification, the open-ended nature of the classes recited in claims 1, 27 and 39 renders the scope of these classes, and thus of the claims themselves, unclear. This frustrates the purpose of 35 U.S.C. § 112, second paragraph, which is to provide those who would endeavor, in future enterprise, to approach the area

circumscribed by the claims of a patent with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. See In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

SUMMARY

The decision of the examiner (1) to reject claims 12, 17 through 20, 23 and 28 through 38 under 35 U.S.C. § 112, second paragraph, is affirmed and (2) to reject claims 1 through 44 under 35 U.S.C. § 103(a) is reversed. Furthermore, a new 35 U.S.C. § 112, second paragraph, rejection of claims 1 through 44 is entered pursuant to 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new

ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

> (b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in

order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b).

NEAL E. ABRAMS)
Administrative Patent Judge)
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JOHN P. MCQUADE)
Administrative Patent Judge) APPEALS AND
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